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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,434	05/05/2004	Niall R. Lynam	DON01 P-1152	3433

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EXAMINER	
AMARI, ALESSANDRO V	

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/709,434	LYNAM, NIALL R.	
	Examiner	Art Unit	
	Alessandro V. Amari	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) 12-21 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 05 May 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 8/25/2004.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-11, drawn to a wide angle reflective element, classified in class 359, subclass 868.

   II. Claims 12-21, drawn to a method for forming a reflective element, classified in class 359, subclass 900.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a reflective element can be formed by lamination.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Timothy Flory on 14 November 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynam US 6,522,451.

In regard to claim 1, Lynam discloses (see for example, Figure 3) a wide angle reflective element for a mirror assembly for a vehicle comprising a wide angle substrate (60) having an exterior surface comprising a less curved inboard portion (F -G) or surface and a more curved outboard portion (G-H) or surface as shown in Figure 3, said substrate comprising a polymeric resin material as described in column 9, lines 13-32, and a glass film (50, 55) disposed at said exterior surface as described in column 7, lines 4-5, said glass film adapted to substantially conform to said exterior surface of said wide angle substrate as shown in Figure 3, said glass film comprising a glass material as described in column 7, lines 4-5.

However, in regard to claim 1, Lynam does not teach that the glass film having a thickness of less than approximately 0.8 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the thickness as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. One would have been motivated to adjust

the thickness for the purpose of improving overall stability/vibration performance of the mirror. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)

Regarding claim 2, Lynam discloses that said glass film comprises a flexible glass film as described in column 7, lines 4-10. Since the applicant's specification does not define the term "flexible" in any terms of degree, the reference is taken to read on this feature.

Regarding claims 3 and 4, Lynam discloses that said substrate is cut from a molded or extruded or cast strip or sheet, said glass film being applied to said strip cut from said strip or sheet, at least two substrates being or sheet as described in column 9, lines 13-52 and regarding claim 4, Lynam discloses including a reflective film applied to said strip or sheet on an inner surface of said substrates opposite said exterior surface as described in column 7, lines 4-22 and column 9, lines 13-52. Applicant should note that claims 3 and 4 are product-by-process claims and in product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 8, Lynam discloses (see Figure 3) that a reflective film (67) applied to said exterior surface of said substrate, said glass film being applied to an exterior surface of said reflective film as shown in Figure 3 and as described in column 7, lines 18-26.

Regarding claim 11, Lynam discloses that said reflective element is adapted for use as an exterior rearview mirror assembly as shown in Figure 1.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynam US 6,522,451 in view of Wheatley et al US 5,262,894.

Regarding claims 9 and 10, Lynam teaches the invention as set forth above but regarding claim 9, does not teach that said reflective film comprises a polymeric reflective film laminated or adhered or otherwise applied to said exterior surface of said substrate and regarding claim 10 does not teach that said reflective film comprises an all polymer thin film multilayer high reflective mirror comprising multiple coextrusion of many plastic layers to form a highly reflective mirror.

Regarding claim 9, Wheatley et al teaches (see Figure 1) that a reflective film is a polymeric reflective film laminated or adhered or otherwise applied to said exterior surface of said substrate and regarding claim 10 teaches that said reflective film comprises an all polymer thin film multilayer high reflective mirror comprising multiple coextrusion of many plastic layers to form a highly reflective mirror as shown in Figure 1 and as described in column 6, lines 65-68, column 7, lines 45-68, column 11, lines 61-68 and column 12, lines 1-11.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the polymeric film of Wheatley et al for the reflective element of Lynam in order to provide for a reflective element which will not corrode or flake.

8. Claims 1-5, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt US 6,030,084 in view of Gillich et al US 6,709,119.

In regard to claim 1, Schmidt teaches (see for example, Figures 2, 3) a wide angle reflective element for a mirror assembly for a vehicle comprising a wide angle substrate (12) having an exterior surface comprising a less curved inboard portion or surface and a more curved outboard portion or surface as shown in Figures 2 and 3, said substrate comprising a polymeric resin material as described in column 3, lines 39-50.

However, in regard to claim 1, Schmidt does not teach a glass film disposed at said exterior surface, said glass film adapted to substantially conform to said exterior surface of said wide angle substrate, said glass film comprising a glass material and having a thickness of less than approximately 0.8 mm.

In regard to claim 1, Gillich et al teaches (see Figure 1) a glass film (101) disposed at said exterior surface, said glass film adapted to substantially conform to said exterior surface of said wide angle substrate, said glass film comprising a glass material as described in column 1, lines 56-67 and column 2, lines 1-5 and having a thickness of less than approximately 0.8 mm as described in column 2, lines 32-39. Regarding claim 2, Gillich et al discloses that said glass film comprises a flexible glass film as described in column as described in column 1, lines 56-67 and column 2, lines 1-5 and 32-39. Since the applicant's specification does not define the term "flexible" in any terms of degree, the reference is taken to read on this feature.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the glass film as taught by Gillich et al in the substrate of Schmidt in order to provide for a protective layer that protects the underlying layers from mechanical damage.

Regarding claims 3 and 4, Schmidt discloses that said substrate is cut from a molded or extruded or cast strip or sheet, said glass film being applied to said strip cut from said strip or sheet, at least two substrates being or sheet as described in column 3, lines 39-65 and regarding claim 4, Schmidt discloses including a reflective film applied to said strip or sheet on an inner surface of said substrates opposite said exterior surface as described in column 3, lines 39-65. Applicant should note that claims 3 and 4 are product-by-process claims and in product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 5, Schmidt teaches (see Figure 2) including a reflective film (15) applied to an inner surface (14) of said substrate opposite said exterior surface as described in column 51-57.

Regarding claim 11, Schmidt discloses that said reflective element is adapted for use as an exterior rearview mirror assembly as described in column1, lines 15-21.

Regarding claim 8, Schmidt in view of Gillich et al discloses the claimed invention as set forth above except for the rearrangement of the reflective film being applied to the exterior surface of the substrate, said glass film being applied to an exterior surface of the reflective film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the reflective film to be applied to the exterior surface of the substrate, since it has been held that a mere rearrangement of elements without modification of the operation of the device involves only routine skill in the art. One would have been motivated to rearrange the reflective film to be applied to the exterior surface for the purpose of easier and more efficient manufacturing of the reflective element. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)

9. Claims 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt US 6,030,084 in view of Gillich et al US 6,709,119 and further in view of Wheatley et al US 5,262,894.

Regarding claims 6, 7, 9 and 10, Schmidt in view of Gillich et al teaches the invention as set forth above but regarding claims 6 and 9, does not teach that said reflective film comprises a polymeric reflective film laminated or adhered or otherwise applied to said inner or exterior surface of said substrate and regarding claims 7 and 10 does not teach that said reflective film comprises an all polymer thin film multilayer high reflective mirror comprising multiple coextrusion of many plastic layers to form a highly reflective mirror.

Regarding claims 6 and 9, Wheatley et al teaches (see Figure 1) that a reflective film is a polymeric reflective film laminated or adhered or otherwise applied to said

exterior surface of said substrate and regarding claims 7 and 10 Wheatley et al teaches that said reflective film comprises an all polymer thin film multilayer high reflective mirror comprising multiple coextrusion of many plastic layers to form a highly reflective mirror as shown in Figure 1 and as described in column 6, lines 65-68, column 7, lines 45-68, column 11, lines 61-68 and column 12, lines 1-11.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the polymeric film of Wheatley et al for the reflective element of Schmidt in view of Gillich et al in order to provide for a reflective element which will not corrode or flake.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ava
16 November 2005

Alessandro Amari
Alessandro Amari
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